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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/057,419	01/25/2002	Craig L. Schmidt	P-7586.01	1349

27581 7590 12/15/2004
MEDTRONIC, INC.
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EXAMINER

SCHAETZLE, KENNEDY

ART UNIT PAPER NUMBER

3762

DATE MAILED: 12/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/057,419

Applicant(s)

SCHMIDT ET AL.

Examiner

Kennedy Schaetzle

Art Unit

3762

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 September 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 18-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 18-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 January 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 18, 19, 21 and 23-30 are rejected under 35 U.S.C. 102(b) as being anticipated by Barreras, Sr. et al. (Pat. No. 5,733,313).

Regarding claim 18, Barreras, Sr. et. al. (Barreras) disclose first and second power sources 44 and 62, a control circuit 46 coupled to the first power source to control the operation of the apparatus, the control circuit being adapted to receive power from the first power source, and a communication circuit (that circuitry generally associated with receiving and transmitting data and power via link 61 and inductor 60) coupled to the second power source (via inductive coupling) to communicate with an external device (26, 40, etc.), the communication circuit being adapted to receive power from the second power source. Related comments apply to independent claim 28.

Regarding claim 23, note col. 8, lines 21-32. Related comments apply to claim 26.

Regarding claim 24, note col. 8, lines 33-43. Related comments apply to claim 27.

Regarding claim 25, the applicants have not invoked the 6th paragraph of §112 and therefore any sensor capable of performing the recited function of sensing the remaining power level of the second power source below a remaining power level threshold would reasonably read on the claim. As disclosed by Barreras, the sensor can detect when the transmitter is moved away from the receiver or is zero volts in the absence of RF energy (see col. 8, lines 21-32). A battery too weak to generate a transmission signal to the implant would cause the implant to “think” the transmitter was

removed from the receiver. The implant is therefore capable of sensing a low battery power condition.

The rejection of claims 29 and 30 parallel the rejection of like claims above.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 20 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barreras, Sr. et al. (Pat. No. 5,733,313).

Barreras, Sr. et al. do not concern themselves with battery chemistry specifics. The examiner took Official Notice in the previous Office Action that lithium chemistry batteries, such as lithium manganese dioxide, lithium silver vanadium oxide, lithium-ion, etc., and nickel/metal-hydride batteries are old and well known to those artisans of ordinary skill in the rechargeable battery arts. The common knowledge or well-known in the art statement is now taken to be admitted prior art because applicant failed to adequately traverse the examiner's assertion of Official Notice. In traversing the rejection of claims 20 and 22, the applicants failed to address the issue of battery chemistry, and instead focused on the issues associated with claim 18 as discussed above.

Response to Arguments

5. Applicant's arguments filed September 21, 2004 have been fully considered but they are not persuasive.

Concerning the rejection of claims 18 and 28, the applicants argue that Barreras, Sr. et al. ("Barreras") discloses the use of an *external* RF transmitting unit and therefore does not teach an implantable medical device that includes both a control circuit and a

communication circuit located in the implantable medical device that are powered by a first power source and a second power source. Rather, it is argued that Barreras teaches to locate the second power source outside of the implantable medical device.

The examiner counters that the claims do not require the second power source to be located within the implantable medical device. It is only required that the implantable medical device comprise a second power source *coupled* to the communication circuit. The examiner considers the implantable medical device of Barreras to have a second power source 62 inductively coupled to the communication circuit.

Conclusion

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

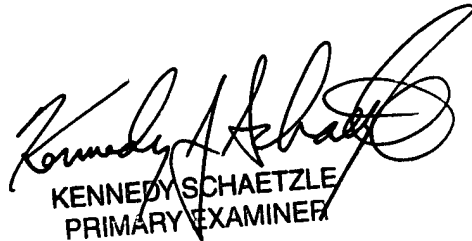
7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kennedy Schaetzle whose telephone number is 571 272-4954. The examiner can normally be reached on M-W and F from 9:30 -6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Angela Sykes can be reached on M-F at 571 272-4955. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 3762

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

KJS
December 12, 2004



KENNEDY SCHAETZLE
PRIMARY EXAMINER